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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/518,495 | 03/03/2000 | Jay S. Walker | 3553-4044US2 | 7612 |

7590 12/18/2001

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EXAMINER

RIMELL, SAMUEL G

ART UNIT

PAPER NUMBER

2166

DATE MAILED: 12/18/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

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| | | |
|------------------------------|------------------------|------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/518,495 | WALKER ET AL. |
| | Examiner Sam Rimell | Art Unit 2166 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on _____.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 144-289 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 144-289 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.

4) Interview Summary (PTO-413) Paper No(s) _____.

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 144-289 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. ('308).

The reasons for this rejection were set forth in the office action of April 25, 2001 and are hereby incorporated by reference.

Remarks

Applicant argues that:

“..the instant rejection is proper only if the subject matter relied upon the examiner can be found in the September 4, 1996 application filing. Applicant respectfully submits that the instant rejection relies upon subject matter not found in the September 4, 1996 filing. In fact, the subject matter relied upon by the Examiner can only be found in applications filed on or after the instant application’s July 8, 1997 filing date”.

In essence, applicant is stating that the Examiner cannot rely upon a complete patent reference, but can only rely upon portions of the patent reference which are common to the earliest filed parent application.

This argument is incorrect.

MPEP 2136.02 states that:

“A 35 U.S.C. 102(e) rejection may rely upon any part of the patent or application publication disclosure”.

This section further states:

“Under 35 USC 102(e), the entire disclosure of a US patent, or an application publication when examining a PG-PUB application (MPEP 2136) having an earlier filing date can be relied upon to reject the claims. *Sun Studs Inc. v. ATA Equip. Leasing, Inc.* 872 F.2d 978, 983, 10 USPQ 2d 1338, 1342 (Fed. Cir. 1989)”.

Thus, applicant has no basis for arguing that the examiner can only partially consider the reference to Walker et al. ('308). The entire reference has to be considered.

In evaluating the correct application of a prior art reference under 35 USC 102(e) containing an earlier priority claim to CIP applications, MPEP 2136.05 provides the relevant test. The test reads as follows:

“(The) Filing date of U.S. Patent application can only be used as the 35 U.S.C. 102(e) date if it supports the claims of the issued child”.

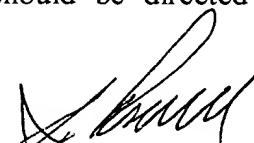
This test does not make any requirement that an examiner “cut up” a prior art reference and only consider portions that are common to the earliest parent case. Rather, the test compares the disclosure of the parent application to the issued child application that is being applied as prior art. Applicant does not provide any evidence or analysis that supports a conclusion that the content of the earliest parent application fails to support the claims of the issued child cases. Lacking such evidence, examiner concludes that the rejection under 35 USC 102(e) is properly applied.

Furthermore, the present application does not include an actual priority claim in either the specification or the declaration. The only claims to priority are mentioned in the transmittal letter submitted with the originally filed application.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (703) 306-5626.



Sam Rimell
Primary Examiner
Art Unit 2166